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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,814	02/13/2002	Mitchell J. Hubert	004027.00019	8084
22910	7590	06/16/2004		
BANNER & WITCOFF, LTD. 28 STATE STREET 28th FLOOR BOSTON, MA 02109-9601			EXAMINER WEBB, GREGORY E	
			ART UNIT 1751	PAPER NUMBER

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/074,814

Applicant(s)

HUBERT ET AL.

Examiner

Gregory E. Webb

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**1) Responsive to communication(s) filed on 4/7/042a) This action is FINAL.      2b) This action is non-final.3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.**Disposition of Claims**4) Claim(s) 19-21 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.6) Claim(s) 19-21 is/are rejected.7) Claim(s) \_\_\_\_\_ is/are objected to.8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.**Application Papers**9) The specification is objected to by the Examiner.10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.**Priority under 35 U.S.C. § 119**12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).a) All    b) Some \* c) None of:1. Certified copies of the priority documents have been received.2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)

Paper No(s)/Mail Date: \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. ~~a.~~
2. The following is in response to the applicant's arguments and amendments filed 4/7/04.
3. Based on the applicant's amendments to the claims, previous objections to claim 19 have been removed. The claims no longer refer to the term "form-forming."

### ***Response to Arguments***

4. Applicant's arguments filed 4/7/04 have been fully considered but they are not persuasive.
5. The applicant makes the following arguments: 1) the prior art fails to teach an "aqueous foam" which is formed with "non-neutral pH aqueous liquid"; 2) the claimed foam composition is used to scrub hazardous vapors; 3) the instant composition is tolerant to high pH swings; and 4) none of the references teach a foamable concentrate with non-neutral pH aqueous liquid.
6. Concerning the first argument, the term "aqueous foam" means foams which contain water. The term "non-neutral" broadly refers to aqueous composition that have a pH other than
7. The prior art compositions generate foam from an aqueous composition and have pH values of either above 7 or below 7 and are thus non-neutral as clearly indicated in the prior action.
7. Concerning the second argument, it should be noted that intended use recitations and other types of functional language cannot be entirely disregarded. However, in composition claims, intended use must result in ***structural difference*** between the claimed invention and the prior art in order to patentable distinguish the claimed invention from the prior art (see MPEP 2111.02). Furthermore, applicant may not rely upon the preamble to distinguish his claimed

composition from that of the prior art, where the preamble does not constitute a limitation of a claim when it states a purpose or intended use (see Loctite Corp. V. Ultraseal Ltd., 781 F.2d 861, 868, 228 USPQ 90, 94 (Fed. Cir. 1985)).

8. Concerning the third argument, the applicant's instant claims do not refer to a tolerance to high pH swings and thus this argument is moot.

9. Concerning argument 4, the prior art teaches aqueous compositions contain water, foam, and have a non-neutral pH. Thus each of these limitations has been met.

10. The examiner appreciates the differences in the applicant's intended use of the composition differs from those of the prior art. However the applicant must rely on material differences to demonstrate the novelty of a composition. If the applicant feels the process of using this composition is novel, then it is suggested that the applicant claim a process and not a material composition.

11. As instant claim 19 stands the examiner is only required to find any composition containing at a minimum water, a foaming surfactant, a foam stabilizing polymer, and a non-aqueous solvent. The examiner reads these material limitations with the broadest interpretation possible. In the instant case, the applicant's claim reads like a hand dishwashing detergent. Hand dishwashing requires water, a foaming surfactant, compounds to maintain high foam (i.e. polymers), and a non-aqueous solvent such as perfumes.

12. The applicant does not address any differences in the actual material limitations in their arguments. It is suggested that if there are material differences between a foam that treats hazardous waste and a foam that treats common dishes, then the applicant should specifically claim those differences. Why can't a dishwashing detergent be used for treating hazardous

waste? What specific chemical(s) in the instant invention demonstrates an improvement over other foaming compositions? It is suggested that these compound be listed and the applicant avoid the broad functional description of their composition.

***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 571-272-1325. The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory E. Webb  
Primary Examiner  
Art Unit 1751

gw